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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,624	08/28/2003	Vincent C. Skurdal	200309874-1	7729
22879 7590 06/13/2007 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER HOFFMAN, BRANDON S	
			ART UNIT 2136	PAPER NUMBER
			MAIL DATE 06/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/650,624

Applicant(s)

SKURDAL ET AL.

Examiner

Brandon S. Hoffman

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-26 are pending in this office action.
2. Applicant's arguments, filed March 13, 2007, have been considered but are moot in view of the new grounds of rejection.

Claim Rejections

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

4. Claims 1-12, 14-20, and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Uchida (U.S. Patent No. 6,370,258).

Regarding claims 1, 10, 14, 20, 23, and 25, Uchida teaches a method/computer-usable media/multifunction copier operating a image processor/multifunction copier, the method comprising:

- A scanner (fig. 1, ref. num 201);
- A digitizer connected to the scanner (fig. 1, ref. num 210);
- A controller connected to the digitizer (fig. 1, ref. num 209); and
- A printer connected to the controller (fig. 1, ref. num 200);

- Generating one or more thumbnail images respectively corresponding to one or more watermarks from data stored in at least one of a memory of the multifunction copier and a removable memory removably connected to the multifunction copier (fig. 4-fig. 7);
- Printing a control document **containing a plurality of watermark images, each watermark image corresponding to watermark data** using the printer (col. 2, lines 29-33);
- Scanning the control document to detect a first user mark **added to the control document after the control document is printed, the user mark** designating one of the **watermark images** for selecting the corresponding watermark (col. 2, lines 25-29 and col. 4, lines 46-63);
- Scanning the printed material; converting the printed material into data corresponding to the printed material using the digitizer (col. 3, lines 10-16);
- Adding the **watermark data** to the printed material to form watermarked material, **wherein the watermarked material comprises the printed material and the image of the designated one of the one or more thumbnail images** (col. 3, lines 44-49); and
- Printing the watermarked material (col. 3, lines 51-58).

Regarding claims 2 and 15, Uchida teaches further comprising printing the watermarked material (col. 2, lines 29-33).

Regarding claims 3 and 16, Uchida teaches wherein printing the watermarked material is a result of detecting a second user mark corresponding to a printing instruction in response to scanning the control document (col. 6, lines 9-23).

Regarding claims 4 and 17, Uchida teaches further comprising sending the data corresponding to the watermarked material to one or more destination addresses as a result of detecting one or more second user marks respectively corresponding to the one or more destination addresses in response to scanning the control document (col. 6, lines 21-32).

Regarding claims 5 and 18, Uchida teaches further comprising displaying the selected one of the one or more watermarks on the printed material according to one or more display options as a result of detecting one or more second user marks respectively corresponding to the one or more display options in response to scanning the control document (col. 6, lines 9-23).

Regarding claims 6 and 19, Uchida teaches wherein adding **the watermark** data corresponding to the selected one of the **watermark images** comprises receiving the **watermark** data corresponding to the selected one of the **watermark images**, as a result of detecting the first user mark, from a removable memory removably connected to the image processor (col. 3, lines 52-59).

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Regarding claim 7, Uchida teaches further comprising placing the image processor in a watermarking mode of operation (fig. 3 and col. 4, lines 19-25).

Regarding claim 8, Uchida teaches wherein placing the image processor in the watermarking mode is in response to detecting an indicator while scanning the control sheet or is in response to the user activating a watermark-mode-selection key of the image processor (fig. 4 and col. 4, lines 34-45).

Regarding claim 9, Uchida teaches wherein printing the control document is in response to the user activating a control-document print key of the image processor (col. 3, lines 52-59).

Regarding claims 11, 22, and 24, Uchida teaches further comprising, before printing the watermark control document, generating the one or more thumbnail images from data corresponding to the one or more corresponding watermarks stored in at least one of a memory of the multifunction copier and a removable memory removably connected to the multifunction copier (fig. 7 and col. 4, lines 46-63).

Regarding claim 12, Uchida teaches wherein adding the selected watermark to the printed material comprises adding data corresponding to selected watermark that is stored in either a memory of the multifunction copier or a removable memory removably

connected to the multifunction copier to data corresponding to the printed material (fig. 7).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13, 21, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida (U.S. Patent No. 6,370,258) in view of Shaffer et al. (U.S. Patent No. 6,434,579).

Regarding claims 13, 21, and 26, Uchida teaches all the limitations of claims 10, 20, and 25, respectively, above. However, Uchida does not teach further comprising displaying the selected watermark on the printed material according to one or more display options as a result of detecting one or more second user marks respectively corresponding to the one or more display options in response to scanning the watermark control document.

Shaffer et al. teaches further comprising displaying the selected watermark on the printed material according to one or more display options as a result of detecting

one or more second user marks respectively corresponding to the one or more display options in response to scanning the watermark control document (fig. 4).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine a second user mark for display options, as taught by Shaffer et al., with the method of Uchida. It would have been obvious for such modifications because allowing a user to select display options provides personalized aesthetic benefits (see col. 5, lines 28-61 of Shaffer et al.).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon S. Hoffman whose telephone number is 571-272-3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brandon Hoffman/
BH

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6/8/07